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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/785,461	02/20/2001	Masahiro Nozaki	P 277124 T36-129082M/AIO	5463

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EXAMINER

STRIMBU, GREGORY J

ART UNIT PAPER NUMBER

3634

DATE MAILED: 12/31/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

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**Office Action Summary**

Application No.

09/785,461

Applicant(s)

NOZAKI, MASAHIRO

Examiner

Gregory J. Strimbu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 August 2002 and 16 October 2002.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2 and 4-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 02 August 2002 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

***Election/Restrictions***

Applicant's election with traverse of restriction requirement in Paper No. 4 is acknowledged. The traversal is on the ground(s) that subject matter of all of the species is sufficiently related that a thorough search for the subject matter of any one species would necessarily encompass a search for the remaining species. This is not found persuasive because the allegations listed above show that the applicant has not analyzed the examiner's action in the context of the established practice for requiring an election of species as set forth in chapter 800 of the MPEP. It is a well established practice that a requirement to elect a single species is a holding by the examiner that the plural species, as claimed, are patentably distinct (i.e., capable of supporting separate patents). See MPEP 808.01(a) and MPEP 809.02(a). If the applicant is of a different view, the applicant need merely clearly state on the record that the species are not patentably distinct. Neither the examiner nor the applicant needs to present any reasoning. Of course, it should be noted that the species that are not patentably distinct are obvious in view of one another. Applicant's response implies that the various species are not considered to be patentably distinct. If this is the case, then the applicant must clearly admit such on the record. The requirement is still deemed proper and is therefore made FINAL.

Claims 6 and 7 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 4.

***Drawings***

The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on August 2, 2002 have been approved.

***Claim Rejections - 35 USC § 112***

Claims 1, 2 and 4-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Recitations such as "so that the flange does not form a wall of said attachment groove" on lines 17-18 of claim 1 render the claims indefinite because it is unclear how the flange cannot form a wall of the attachment groove when lines 4-5 of claim 1 set forth that the root portion of the flange provides for the U shaped attachment groove.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 4, 5 and 8-10 are rejected under 35 U.S.C. 102(b) as being anticipated by British Patent Publication No. 2 312 460. British Patent Publication No. 2 312 460 discloses a trim and glass run attachment structure 5 in a vehicle door comprising a flange 44B provided on a window frame of the vehicle door, a U-shaped

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attachment groove 44 provided by a door exterior side (not numbered, but comprising the left most portion of the flange 44A as seen in figure 3) and an outer circumferential side of the flange 44B at a root portion thereof, a lock protrusion strip 52 provided on a door interior side wall of the attachment groove at the root portion of the flange, a trim 54 having a substantially U shaped section and attached to the flange, and a glass run 40 formed separately from the trim, having a glass run body (not numbered, but seen in figure 3) attached into the attachment groove, the glass run body having a lock protrusion strip 48 engaging with the lock protrusion strip 52 of the attachment groove to retain the glass run body in the groove, wherein a part of the trim is in contact with the glass run when the trim is attached to the flange, wherein a door exterior part of the flange and a door interior part of the attachment groove are integrally formed as a single component, and wherein the flange and attachment groove are formed in series from a door interior to a door exterior, so that the flange does not form a wall of the attachment groove.

***Allowable Subject Matter***

Claim 11 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: the prior art of record, absent applicant's own disclosure, fails to teach the entire combination of elements set forth in the claimed invention. Specifically, the prior

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art of record fails to teach the glass run body including opposing side walls each providing a seal lip, the seal lips structured to engage opposing side walls of a window glass. See claim 11, lines 2-3.

### ***Response to Arguments***

Applicant's arguments filed August 2, 2002 have been fully considered but they are not persuasive.

With respect to the applicant's comments concerning British Patent Publication No. 2 312 460, the examiner respectfully disagrees. The flange 44B of British Patent Publication No. 2 312 460 as shown in figure 3 does not extend the entire height of the attachment groove 44. Thus, the attachment groove could be interpreted as extending from the bottom portion of the flange 44B to the bottom of the groove 44, as shown in figure 3. With such an interpretation, the flange 44B would not form a wall of the attachment groove.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J. Strimbu whose telephone number is 703-305-3979. The examiner can normally be reached on Monday through Friday 8:00 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on 703-308-2686. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3597 for regular communications and 703-305-3597 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-2168.

A handwritten signature in black ink, appearing to read "Gregory J. Strimbu", with a stylized flourish at the end.

Gregory J. Strimbu  
Primary Examiner  
Art Unit 3634  
December 30, 2002